

The Examiner states that all of the above prior art forms their respective heterogenite material by heating to the same or similar temperature as used by the Applicants. As proof the Examiner points to Yamada, col. 3, l. 59, and the Abstract of '970. With respect to Yamada et al., the Applicants respectfully assert that the Examiner is in error. Yamada et al. does not form a heterogenite material by heating; Yamada applies a heat-treatment to a heterogenite material. Yamada states that "cobalt compounds [substantially represented by the formula  $\text{HCoO}_2$ ] can stably be used as the cobalt compound of the present invention either directly or after a heat-treatment." Col. 3, ll. 53-57 (emphasis added). The heterogenite material of Yamada is a starting material and not an end product. Yamada does not teach how to obtain the heterogenite starting material. Therefore, the Applicants' claimed heterogenite powder cannot be inherently anticipated by or obvious in view of this nondisclosure.

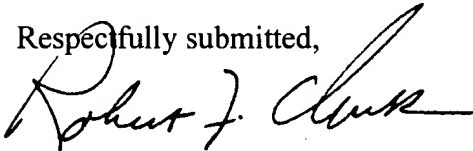
The same lack of disclosure applies to the Abstract of '970. The heterogenite material is described as being formed as a layer on a nickel hydroxide particle and then heated. The Abstract does not teach forming the heterogenite layer by heating. In addition to not describing a process analogous to the Applicants' process, the Applicants would like to bring to the Examiner's attention to a recent non-precedential decision of the Board of Patent Appeals and Interferences. *Ex parte Jones*, 62 USPQ2d 1207 (BPAI 11/28/01) In *Ex Parte Jones*, the Board stated that it continues to have recurring problems with citations and reliance by Examiners on abstracts without citation and reliance on the underlying documents. *Id.* at 1208. It was the view of the Board that this practice is generally inappropriate when both the abstract and the underlying document are prior art. The Board stated that the preferred practice is for the Examiner to cite and rely on the underlying document and furthermore that the Examiner should provide a translation upon request of the applicant when the document is in a foreign language. Thus, in response to this reply, the Applicants request that the Examiner at the very least should withdraw the rejection based on the Abstract of '970, obtain a translation of the underlying document, JP 10-188970, and, if warranted, issue a new rejection supported by the translation. In this way, a proper record can be presented for appeal if the Examiner eventually does not find the Applicants arguments to be persuasive.

Finally, as a catch-all, the Examiner asserts that one of ordinary skill in the art would be aware of the relationship between surface area and such parameters as particle size, density, and packing factors and that one of ordinary skill in the art would have been able to control the particle size of the heterogenite material obtained in the prior art through control of one or more of these parameters given the disclosures of Yamada or JP '970. The Applicants' respectfully disagreed with this contention in their prior response and requested that the Examiner provide additional

documentary evidence. No such evidence has been produced. The Applicants respectfully assert that general knowledge of the relationship between particle size, surface area, density and packing factors does not teach or suggest how to make a high-surface-area heterogentite powder as claimed by the Applicants. It is well established that common knowledge and common sense do not substitute for authority when the law requires authority. *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). When an assertion of general knowledge is made to negate patentability, that knowledge must be articulated and placed of the record. *Id.* at 1435. The law requires more than just the Examiner's conclusory statements. The Applicants respectfully assert that the Examiner has not articulated how general knowledge of the above-mentioned relationships makes obvious the Applicants' claimed invention. Therefore, the Applicants respectfully request that the Examiner withdraw this grounds for rejection or provide the required authority and a well-reasoned argument so that the Applicants are afforded a fair opportunity to make arguments in rebuttal.

In view of the foregoing response, it is believed that the Examiner's rejections have been overcome and that the application is in condition for allowance. Such action is earnestly solicited.

Respectfully submitted,



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